

REMARKS

In the Office Action dated March 3, 2004, the Examiner rejected claims 12 and 13 under 35 U.S.C. § 112, second paragraph; rejected claims 1 and 3-30¹ under 35 U.S.C. § 102(e) as being anticipated by Mullins (U.S. Patent Application Publication 2002/0091702); and rejected claim 2 under 35 U.S. C. § 103(a) as being unpatentable over Mullins in view of Sidles (U.S. Patent Application Publication No. 2002/0062342).

By this amendment, Applicants have amended claims 12 and 13. Based on these amendments and the following remarks, Applicants respectfully traverse the rejection of claims 1-30 under U.S.C. §§ 102(e) and 103(a).

I. The Rejection under 35 U.S.C. § 112, second paragraph

In accordance with the Examiner's comments, Applicants have amended claims 12 and 13 to remove the phrase "may be." Accordingly, Applicants submit that the rejection of these claims under 35 U.S.C. § 112, second paragraph, are now moot and request that the rejection be withdrawn.

II. The Examiner has not shown that Mullins is prior art under 35 U.S.C. §§ 102(e) and 103(a)

To qualify as prior art under 35 U.S.C. § 102(e), the "disclosure relied on in the rejection must be present in the ... application publication." See *MPEP* § 2136.02. Further, "[i]n order to carry back the 35 U.S.C. § 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must (A) have

¹ Applicants note that the Examiner rejects claims 1-30 under 35 U.S.C. § 102(e) on page 3 of the Office Action, but did not address claim 2 in the body of the rejection. Instead, the Examiner rejects this claim under 35 U.S.C. § 103(a). Thus, Applicants assume that the rejection of claim 2 under 35 U.S.C. § 102(e) was inadvertent and therefore will not address this claim under that Section of Title 35.

a right of priority to the earlier date under 35 U.S.C. 120 ... and (B) support the invention as claimed as required by 35 U.S.C. 112, first paragraph." See *MPEP 2126.03 (IV) (citing, inter alia, Ex parte Gilderdale, 1990 Pat. App. LEXIS 25 (Bd. Pat. App. & Inter. Appeal no. 89-0352.)* In Gilderdale, the Board reversed the rejection under 35 U.S.C. § 102(e) because the reference relied upon by the Examiner was not entitled to the filing date of the CIP grandparent application because the "parent and child applications contained new mater as compared to the grandparent." *Id.*

In this case, Mullins has a filing date of November 15, 2001. Applicants filing date is June 7, 2001, predating the filing date of Mullins. The reference, however, claims priority as a continuation-in-part of application no. 60/249,418, filed November 16, 2000. Accordingly, unless the parent '418 application supports the invention as claimed in Mullins, the priority date of November 16, 2000, cannot be relied upon by the Examiner to reject claims 1-30 under 35 U.S.C. §§102(e) or 103(a). Because Mullins is a CIP of the '418 application, there is new matter present in Mullins.

According to 37 C.F.R. § 1.104(c), the "pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Because Mullins is a CIP of the '418 application, it is not apparent what subject matter disclosed in Mullins qualifies for the priority date of the '418 application. Accordingly, the Examiner has the initial burden to show the pertinence of this reference in rejecting claims 1-30, which includes specifying whether the subject matter relied upon by the Examiner in the rejections is not new matter.

In light of the foregoing arguments, Applicants submit that Mullins is not eligible as prior art under 35 U.S.C. § 102(e) because the filing date of that reference is after

the filing date of Applicants' application and the reference claims priority of the '418 application as a CIP. Accordingly, unless the Examiner provides evidence that the subject matter relied upon in Mullins is not new matter when compared to the parent '418 application, the rejection of claims 1-30 under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn.

III. The Rejection of Claims 1 and 3-30 under 35 U.S.C. § 102(e)

The Examiner asserts that Mullins anticipates claims 1 and 3-30. Based on the above arguments, Applicants traverse the Examiner's assertions and the rejection of claims 1 and 3-30 because Mullins is not eligible as prior art pursuant to 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

IV. The Rejection of Claim 2 under 35 U.S.C. § 103(a)

Applicants further traverse the rejection of claim 2 because, as explained, Mullins is not eligible as prior art pursuant to 35 U.S.C. § 102(e) and thus cannot qualify as prior art under 35 U.S.C. § 103(a). Accordingly, Mullins cannot support the rejection of claim 2.

Further, Applicants traverse the rejection of claim 2 because the Examiner failed to designate the particular part relied upon in Sidles, as required by 37 C.F.R. § 1.104(c)(2) and MPEP § 707. In particular, 37 C.F.R. § 1.104(c)(2) states that "[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as

practicable." Here, the Examiner did not even cite to a portion of Sidles in support of the assertions set forth in the Office Action. Accordingly, Applicants submit the rejection of this claim is improper and should be withdrawn.

Accordingly, the cited art does not support the rejection of claim 2, and as a result, the Examiner has not presented a prima facie case of obviousness. Therefore, Applicants respectfully request that the rejection of this claim be withdrawn and the claim allowed.

V. Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the cited art. Applicant therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of claims 1-30.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 2, 2004

By: _____


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